

Application No.: 10/039,570
Response dated January 11, 2008
Reply to Office Communication dated December 12, 2007

REMARKS

In the Office Communication, the U.S. Patent Examiner has requested Applicants to provide the United States Patent and Trademark Office with a discussion of specific distinctions as to how the claims define patentably beyond the prior art. Accordingly, Applicants have now filed this Supplemental Amendment, which amendment supersedes the previously filed Amendment B, and additionally includes the noted discussion as requested by the U.S. Patent Examiner. It is believed that Supplemental Amendment B should replace the previously filed Amendment B, and further consideration of the application should stem from the present amendment.

In Paragraph Nos. 6 and 7 of the Office Action dated February 24, 2003, Claim Nos. 1 – 10, 15 – 17, 19, 20, 23, 24, and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,071,256, which issued to Kimmel. The U.S. Patent Examiner stated, as follows:

“Kimmell teaches a skateboard comprising an elongated board (50), to which is attached a pair of opposingly raked truck assemblies (note figures 2, 5), comprising a truck (52, 54) comprising a wheel support (60) pivotably associated with the board, an elastomeric spring (120) of substantially cylindrical configuration connected to the support, wheels (64, 66) rotatably mounted to the support, a base (56, 57) secured to the board, the spring engaging the wheel

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support (through 106, 126) and the base (through 128, 130, and 86, 88); the truck including a housing (134) and a lug shaft (90, 92, 94, 106) which engages the base and the housing, the engagement with the base being rigid when the lug is tightened, the housing allowed to pivot with respect to the shaft, the shaft defining a spline (e.g. 116), which extends outwardly and which engages with a keyway (e.g. 126) in the spring; the truck further comprising an outer hollow cylinder (78) which is associated with the housing, and has at least one spline (86, 88) wherein the spring further defines at least one keyway (128, 130) for receiving the outer spline."

In Paragraph Nos. 6 and 8 of the Office Action dated February 24, 2003, Claim Nos. 1 – 8, 11 – 13, and 19 – 23 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,047,725, which issued to Pinchok. The U.S. Patent Examiner stated, as follows:

"Pinchok teaches a skateboard including an elongated board (74), a raked truck including a wheel support (26) pivotably associated with the board, a cylindrical elastomeric spring (59) connected to the support, wheels (12) mounted to the support, a base (27/36) for mounting to the board, the spring engaging the wheel support (through 60 and 58) and the base (through 64, 62, 43, 42, and 40), further including a housing (57) and a lug shaft (34), which engages both the base and housing, being rigidly associated with the base, when tightened, and pivotally associated with the housing; the spring being received within the housing (57, 58

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59, 60), further including an end cap (37, 38) which engages the shaft and retains the spring in the housing, and further including a retaining clip element (42, 43) which is releasably engaged with the cap.”

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35 U.S.C. §102(b) REJECTIONS

ISSUE:

The issue(s) thus presented by the U.S. Patent Examiner is (1) whether Claim Nos. 1 – 10, 15 – 17, 19, 20, 23, 24, and 26 are anticipated by Kimmel and (2) whether Claim Nos. 1 – 8, 11 – 13, and 19 – 23 are anticipated by Pinchok for the reasons stated.

RULE(S):

In *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), the Federal Circuit Court stated that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ at 313 (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)).

It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as further stated by the Federal Circuit Court, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)(emphasis added).

The Federal Circuit Court has indicated that “[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their

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meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ at 485.

Further, "[u]nder 35 U.S.C. 102, anticipation requires that ... the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2D 1241, 1245 (Fed. Cir. 1986)(citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (C.C.P.A. 1964)). The Federal Circuit Court has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

By combining the elements of the various decisions, a *prima facie* case of anticipation is established when a U.S. Patent Examiner provides:

- 1) a single reference
- 2) that teaches or enables
- 3) each of the claimed elements (arranged as in the claim)
- 4) expressly or inherently
- 5) as interpreted by one of ordinary skill in the art.

An applicant who is able to prove that any one of these elements is not present will effectively prevent the *prima facie* case of anticipation from being established.

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ANALYSIS

In this case, Independent Claim No. 1, as amended, recites, as follows:

I. A two-wheeled, in-line skateboard comprising:

a substantially planar, elongated board, the elongated board having first and second board ends;

first and second truck assemblies, the first truck assembly being cooperatively associated with the first board end, the second truck assembly being cooperatively associated with the second board end, each truck assembly comprising

a wheel support pivotably associated with the elongated board, the wheel supports each being pivotable about a pivot axis, the pivot axes extending substantially orthogonally to the elongated board, each wheel support comprising in-line wheel positioning structure;

a spring connected to the wheel support for resisting pivoting of the wheel support relative to the elongated board; and

first and second in-line wheels, the in-line wheels being rotatably mounted to the wheel supports via the in-line wheel positioning structure, the in-line wheel positioning structures centering the first and second in-line wheels relative to the wheel supports.

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Independent Claim No. 19, as amended, recites, as follows:

19. A two-wheeled, in-line skateboard comprising:

a substantially planar, elongated board, the elongated board having first and second board ends;

first and second truck assemblies, the first truck assembly being cooperatively associated with the first board end, the second truck assembly being cooperatively associated with the second board end, each truck assembly comprising

a base rigidly secured to the elongated board;

a wheel support pivotably associated with the base, the wheel supports each being pivotable about a pivot axis, the pivot axes extending substantially orthogonally to the elongated board, each wheel support comprising in-line wheel positioning structure;

a spring engaging the wheel support and the base for resisting pivoting of the wheel support relative to the base; and

first and second in-line wheels, the in-line wheels being rotatably mounted to the wheel supports via the in-line wheel positioning structure, the in-line wheel positioning structures centering the first and second in-line wheels relative to the wheel supports.

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Independent Claim No. 24, as amended, recites, as follows:

24. A two-wheeled, in-line skateboard comprising:

a substantially planar, elongated board, the elongated board having first and second board ends;

first and second truck assemblies, the first truck assembly being cooperatively associated with the first board end, the second truck assembly being cooperatively associated with the second board end, each truck assembly comprising

a base rigidly secured to the elongated board;

a wheel support pivotably associated with the base, the wheel supports each being pivotable about a pivot axis, the pivot axes extending substantially orthogonally to the elongated board, each wheel support comprising in-line wheel positioning structure;

a spring engaging the wheel support and the base for resisting pivoting of the wheel support relative to the base, the spring comprising a substantially cylindrical elastomer; and

first and second in-line wheels, the in-line wheels being rotatably mounted to the wheel supports via the in-line wheel positioning structure, the in-line wheel positioning structures centering the first and second in-line wheels relative to the wheel supports.

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Applicants concede that Kimmell indeed teaches a skateboard, which skateboard comprises an elongated board, to which is attached a pair of opposingly raked truck assemblies. Each truck assembly of the Kimmell disclosure comprises a truck having a wheel support pivotably associated with the board, and an elastomeric spring of substantially cylindrical configuration connected to the support.

Each truck assembly of the Kimmell skateboard, however, comprises two laterally opposed wheels rotatably mounted to the wheel support. Each truck assembly of the present invention receives one wheel, such that the first and second wheels are in-line with one another, said first and second wheels being centered relative to the in-line wheel positioning structures. The laterally opposed wheels of the Kimmell disclosure are clearly not centered relative to any in-line wheel positioning structure.

Further, the truck assemblies of the present invention are each pivotable about an axis of rotation, which axes of rotation extend substantially orthogonally to the plane of the board. In other words, the axes of rotation are substantially parallel and coplanar. The axes of rotation extending through the trucks of the Kimmell skateboard are angled relative to the plane of the board, and while also coplanar, would appear to intersect one another.

The dependent Claim Nos. 2 – 10, 15 – 17, 20, 23, and 26 depending from the above claims respectively, are thus believed to also be distinctive from the Kimmell disclosure by virtue of their respective dependencies.

Applicants further concede that Pinchok teaches a skateboard, which skateboard teaches an elongated board, opposed raked trucks including a wheel support pivotably

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associated with the board via a base, and a cylindrical elastomeric spring connected to the support. Each truck assembly of the Pinchok disclosure, however, comprises two laterally opposed wheels rotatably mounted to the wheel support.

Each truck assembly of the present invention receives one wheel, such that the first and second wheels are in-line with one another, said first and second wheels being centered relative to the in-line wheel positioning structures. The laterally opposed wheels of the Pinchok are also clearly not centered relative to any in-line wheel positioning structure.

Further, the truck assemblies of the present invention are each pivotable about an axis of rotation, which axes of rotation extend substantially orthogonally to the plane of the board. In other words, the axes of rotation are substantially parallel and coplanar. The axes of rotation extending through the trucks of the Pinchok skateboard are angled relative to the plane of the board, and while also coplanar, would appear to intersect one another.

The dependent Claim Nos. 2 – 8, 11 – 13, and 20 – 23 depending from the above independent Claim Nos. 1 and 19, respectively, are thus believed to also be distinctive from the Pinchok disclosure by virtue of their respective dependencies.

In Paragraph Nos. 9 and 10 of the Office Action dated February 24, 2003, Claim Nos. 14 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kimmell as modified by U.S. Patent No. 1,056,357, which issued to Murdock. The U.S. Patent Examiner stated, as follows:

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“[Kimmell] fails to teach the wheel support as including a pair of fork members with an axle engaged with the fork members. Murdock teaches a wheel mount for a skate board, including a wheel (10) mounted by an axle (not referenced), on a pair of fork members (9) which are pivotally mounted with respect to a base (6) which is in turn rigidly mounted to a board (1). It would have been obvious to one of ordinary skill in the art at the time the invention to replace the through axle (68) mounted on the truck portion (60) as taught by Kimmell, with a wheel axle, mounted to a pair of fork members extending from a truck, as taught by Murdock, for the purpose of moving the axle further from the pivot axis of the truck, to enhance the turning action of the board, making it more responsive to small shifts in the rider's weight.”

In Paragraph Nos. 9 and 11 of the Office Action dated February 24, 2003, Claim Nos. 15 – 17 and 24 – 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchok. The U.S. Patent Examiner stated, as follows:

“[Pinchok] fails to explicitly teach the provision of two wheel assemblies, raked in opposing directions. The provision of a pair of wheel assemblies being oppositely raked, on a skateboard is very old and well known, and the examiner hereby takes Official Notice of such provision. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a pair of the assemblies taught by Pinchok, raked in opposite directions, for the purpose of providing an operable skateboard which may be easily steered.”

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35 U.S.C. §103(a) REJECTIONS

ISSUE:

The issue(s) thus presented by the U.S. Patent Examiner are (1) whether Claim Nos. 14 and 18 are obvious in view of Kimmel as modified by Murdock, and (2) whether Claim Nos. 15 – 17 and 24 – 26 are obvious in view of Pinchok as modified by old, well known art.

RULES:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made [35 U.S.C. § 103(a)].

U.S. Patent Examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. [Manual of Patent Examining Procedure (M.P.E.P.), § 2141]. Further, United States Patent and Trademark Office (Office) policy has consistently been to follow the three prong test enunciated in *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966) (*Graham*) in the consideration and determination of obviousness under 35 U.S.C. 103. U.S. Patent Examiners are thus behooved to apply the test for patentability under 35 U.S.C. 103 as set forth in *Graham* when considering rejections of

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patent claims based on 35 U.S.C. 103. Furthermore, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. [M.P.E.P. § 2141.02; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)].

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (M.P.E.P. § 2413).

If a U.S. Patent Examiner does not demonstrate all elements of the *prima facie* case, the U.S. Patent Examiner's opinion of obviousness is deficient and the applicant is deserving of a patent. The Federal Circuit has endorsed this view in *In re Oetiker*, stating, "if the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443-1444 (Fed. Cir. 1992).

An applicant who is able to prove that any one of these elements is not present will effectively prevent the *prima facie* case of obviousness from being established. Notably, the three prong test enunciated in *Graham* was most recently upheld by the U.S. Supreme Court ruling in *KSR International Co. v. Teleflex Inc. et al.* 550 U.S. ____, 127 S. Ct. 1727 (2007).

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ANALYSIS

In this case, dependent Claim Nos. 14 and 18 ultimately depend from Claim No.

1. Claim No. 1 is distinctive from the Kimmel disclosure for the reasons previously set forth. Interestingly, Murdock may be roughly described as coaster having in-line wheels, one of which (i.e. the rearward wheel) is fixedly mounted to a rider support board (i.e. there is no rotation about an axis extending through the board), and the other of which (the forward wheel) is rotatably mounted to the rider support board. The rearward wheel thus prevents rotation about an axis extending through the board, and the forward wheel allows free rotation about an axis extending (non-orthogonally) through the board.

Murdock has been cited to modify Kimmell, however, to include a fork structure for accepting a wheel axle. Applicants again concede that Kimmel teaches a skateboard, which skateboard teaches an elongated board, opposed raked trucks including a wheel support pivotably associated with the board, and a cylindrical elastomeric spring connected to the support. Each truck assembly of the Kimmel disclosure, however, comprises two laterally opposed wheels rotatably mounted to the wheel support.

It is unclear how Kimmell as modified by Murdock would be successfully practiced. Presumably, each of the laterally opposed wheels of the Kimmell would either have to be received with laterally opposed, separate fork assemblies or both laterally opposed wheels would have to be received within a single fork assembly spanning both laterally opposed wheels. The modification of Kimmell by Murdock is thus highly questionable given the other support structures involved.

Nevertheless, the truck assemblies of the present invention are each pivotable about an axis of rotation, which axes of rotation extend substantially orthogonally to the

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plane of the board. In other words, the axes of rotation are substantially parallel and coplanar. The axes of rotation extending through the trucks of the Kimmel disclosure as modified by Murdock would appear to be angled relative to the plane of the board, and while also coplanar, would appear to intersect one another. Notably, Murdock, as isolated from Kimmell, discloses only a single of axis of rotation extending non-orthogonally relative to the board.

Dependent Claim Nos. 15 – 17 ultimately depend from Claim No. 1, and dependent Claim Nos. 25 and 26 ultimately depends from Claim No. 24. Claim Nos. 1 and 24 are distinctive from the Pinchok insofar as Pinchok teaches a skateboard, which skateboard teaches an elongated board, opposed raked trucks including a wheel support pivotably associated with the board via a base, and a cylindrical elastomeric spring connected to the support. Each truck assembly of the Pinchok disclosure comprises two laterally opposed wheels rotatably mounted to the wheel support.

Each truck assembly of the present invention receives one wheel, such that the first and second wheels are in-line with one another, said first and second wheels being centered relative to the in-line wheel positioning structures. The laterally opposed wheels of the Pinchok are also clearly not centered relative to any in-line wheel positioning structure.

Further, the truck assemblies of the present invention are each pivotable about an axis of rotation, which axes of rotation extend substantially orthogonally to the plane of the board. In other words, the axes of rotation are substantially parallel and coplanar. The axes of rotation extending through the trucks of the Pinchok skateboard are angled

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relative to the plane of the board, and while also coplanar, would appear to intersect one another.

It is unclear how Pinchok as modified by well known art would be successfully practiced. Presumably, each of the laterally opposed wheels of the Pinchok disclosure would either have to be received with laterally opposed, separate fork assemblies or both laterally opposed wheels would have to be received within a single fork assembly spanning both laterally opposed wheels. The modification of Pinchok by well known art is thus highly questionable given the other support structures involved.

Nevertheless, the truck assemblies of the present invention are each pivotable about an axis of rotation, which axes of rotation extend substantially orthogonally to the plane of the board. In other words, the axes of rotation are substantially parallel and coplanar. The axes of rotation extending through the trucks of the Pinchok disclosure as modified by well known art would appear to be angled relative to the plane of the board, and while also coplanar, would appear to intersect one another.

CONCLUSIONS

Applicants point out that claim language is purposeful and not accidental. The noted limitations as appearing in the rejected claims, including the limitations as currently amended have been purposefully recited in an effort to properly claim the subject matter that Applicants regard as their invention.

It is believed that the U.S. Patent Examiner has not demonstrated all the required elements of the *prima facie* cases with regard to either alleged anticipation of the noted claims or with regard to alleged obviousness of the Claim Nos. 14, 24, and 25. Thus, it is Applicant's contention that the U.S. Patent Examiner's opinions of anticipation and

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obviousness are deficient, particularly in view of the claims as currently amended, and that Applicant is deserving of the allowance of the noted claims.

With further regard to the Office Action, the U.S. Patent Examiner indicated that the Oath/Declaration was defective for the reasons stated in Paragraph No. 1. A substitute Declaration has been submitted listing five (5) available applicants with complete residential addresses. All five (5) available applicants have signed and dated the substitute Declaration.

With regard to Paragraph No. 2 of the Office Action, Applicants take note that Geoffrey Boyer is listed on a cover sheet as being among the contributing inventors. Mr. Geoffrey Boyer, although initially contacted to provide a contribution, never made a contribution to the subject matter disclosed in the subject application and thus Mr. Boyer was not included among those making Declaration(s) as to bona fide inventorship. Geoffrey Boyer is not an inventor in the subject application.

With regard to Paragraph No. 3 of the Office Action, Applicants take note that 37 C.F.R. 1.98(a)(2) requires (or used to require) a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. In response to the U.S. Patent Examiner's request, Applicants previously submitted a complete legible copy of each prior art reference as submitted with the original filing.

With regard to Paragraph No. 4 of the Office Action, the Specification has now been amended in an attempt to cure the informalities objected to by the U.S. Patent Examiner.

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With regard to Paragraph No. 6, of the Office Action, Claim No. 14 has been amended in an attempt to cure the informality prompting the U.S. Patent Examiner's rejection thereof under 35 U.S.C. 112.

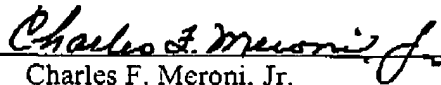
With regard to Paragraph Nos. 6 – 11 of the Office Action, Applicants have elected to amend and/or cancel certain claims as originally presented as a means to overcome the rejections of record. The U.S. Patent Examiner is kindly requested to reconsider the rejections of record in view of the amendments and/or cancellations made to the claims, and in view of the discussion presented hereinabove.

Notably, as a means to provide certain antecedent support for the claim amendments, certain specification amendments have also been newly drafted and incorporated into the specification by way of amendment(s). It is believed that no "new matter" has been presented in this amendment as the Applicant has merely rephrased or reworded certain motions with language perhaps deemed more precise for claiming purposes.

It is believed that this amended patent application is now in a better condition for allowance, and such action is kindly requested. If, after a review of this Amendment, issues remain which may be resolved by a telephone interview, the U.S. Patent Examiner is cordially invited to call the Applicants' undersigned attorney.

Respectfully submitted,
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